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DEC 14 2007

OFFICE OF PETITIONS

In re Application of Carmichael et al. :
Application No. 09/493,756 :
Filing Date: January 28, 2000 :
Attorney Docket No. 21100-003001 :

Decision on Petition

This is a decision on the petition under 37 CFR 1.137(a), filed October 27, 2006, to revive the above-identified application.

The petition is **DISMISSED**.

Facts:

The Office mailed a non-final Office action on June 20, 2002, set a shortened statutory period for reply of three (3) months.

During, or before, August 2002, inventor and partial owner of the assignee Connie Jordan (formerly Connie Carmichael), learned the law firm of Lyon & Lyon had begun taking steps to dissolve the law firm.

On August 28, 2002, the assignee revoked all prior power of attorneys and requested the Office mail all future correspondence to the assignee's address listed on the revocation form.

Petitioner did not file a reply to the June 20, 2002 Office action. As a result, the application became abandoned as of September 21, 2002.

The Office mailed a Notice of Abandonment to the assignee on January 29, 2003. The Notice states, on January 22, 2003, the examiner informed Ms. Connie Carmichael that the Office had never received a response to the June 20, 2002 Office action. The Office attached an 8 page discussion of the methods by which one can revive an abandoned application to the Notice of Abandonment.

During, or about, the end of March 2003, petitioner obtained a copy of what was believed to be all of its files from Lyon & Lyon.

Connie Jordan states petitioner was unable to obtain counsel until July 2003. Petitioner retained the law firm of Ardell & St. George.¹ Ms. Jordan contends, once the new law firm learned of the incomplete nature of the files obtained from Lyon & Lyon, the new law firm withdrew.

Ms. Jordan states, "On or about July 12, 2004," assignee received papers regarding Lyon & Lyon's bankruptcy and learned the bankruptcy trustee was David Gill. Ms. Jordan contacted Gill but was unable to find a feasible way to obtain the missing files from the bankruptcy estate.

Ms. Jordan states her previous attorney at Ardell & St. George told her "the patent application process could not be continued without complete files."²

During or around May of 2005, Ms. Jordan met Attorney Scott Harris of Fish & Richardson, P.C. Attorney Harris was subsequently able to obtain all the missing files and informed Ms. Jordan several of the applications were abandoned.

The instant petition was not filed until October 27, 2006.

Discussion:

A grantable petition under 37 CFR 1.137(a) must be accompanied by:

- (1) the reply required to the outstanding Office action or notice, unless previously filed,
- (2) the petition fee,
- (3) a showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable, and
- (4) a terminal disclaimer and fee *if* the application was filed on or before June 8, 1995 or *if* the application is a design application.

The instant petition lacks items (1) and (3).

As to item (1), the petition does not include a reply to the outstanding June 20, 2002 non-final Office action. A petition under 37 CFR 1.137 must be accompanied by a reply to the outstanding Office action or notice, unless such a reply was previously filed. Since a reply has not been filed, the petition cannot be granted.

As to item (3), the showing of record is not sufficient to establish to the satisfaction of the Commissioner that the delay was unavoidable within the meaning of 37 CFR 1.137(a).

"[T]he question of whether an applicant's delay in prosecuting an application was unavoidable must be decided on a case-by-case basis, taking all of the facts and circumstances into account."³

¹ The Office notes petitioner may be intending to refer to the law firm of St. George & Carnegie. Ardelle St. George is a principle of the law firm of St. George & Carnegie.

² Page 6 of Ms. Jordan's declaration.

³ Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (1982).

In order for a party to prove unavoidable delay, the Office requires the party demonstrate the party exercised the "care or diligence tha[t] is generally used and observed by prudent and careful men in relation to their most important business."⁴

Ms. Jordan knew the instant application was abandoned by at least January 22, 2003. Once Ms. Jordan learned the application was abandoned, she became responsible for acting diligently in having the application revived.

Although petitioner did not obtain all of its files from Lyon & Lyon, the petition indicates petitioner did receive 4 boxes of files.

Petitioner was aware of the existence of the instant application and the fact it was abandoned as early as January 22, 2003. A reasonable and prudent person, treating the instant patent the same as the person would treat his or her most important business, would have taken steps to learn if the file for the instant file was in the boxes.

The petition does not assert the file for the instant application was missing from the boxes. If petitioner did receive the file for the instant application, applicant has failed to prove no law firm would represent petitioner with respect to the instant application. The fact law firms might not represent petitioner concerning all matters previously handled by Lyon & Lyon is not necessarily an indication such law firms would not assume responsibility for the instant application.

Even if all matters formerly handled by Lyon & Lyon needed to be handled by a single law firm or single attorney, petitioner has failed to prove, despite diligence, petitioner was unable to find representation. Petitioner fails to list any of the law firms or attorneys contacted. Petitioner has failed to indicate the number of law firms and attorneys were contacted.

If petitioner did not receive the file, then the instant petition appears to be based primarily on Ms. Jordan's belief prosecution of an application was impossible absent possession of Lyon & Lyon's complete file for the application. However, Ms. Jordan fails to assert she, or any other officer of assignee, took any steps to learn about patent prosecution or to contact the USPTO with respect to petitioner's patent and trademark matters. The petition fails to demonstrate, if Ms. Jordan or another officer of assignee had taken such steps, petitioner would have failed to learn possession of the complete files was not necessary for Ms. Jordan to revive and prosecute the instant application.

Ms. Jordan states her previous attorney at Ardell & St. George told her "the patent application process could not be continued without complete files." Ms. Jordan has not proven an attorney informed her the complete files were absolutely necessary in order to prosecute any of petitioner's applications for patent. Ms. Jordan has not named the attorney or provided a statement by the attorney verifying the attorney provided Ms. Jordan with such information.

⁴ In re Mattulath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912). See also Ray v. Lehman, 55 F.3d 606, 34 U.S.P.Q.2d (BNA) 1786 (Fed. Cir. 1995) (citations omitted) ("[I]n determining whether a delay in paying a maintenance fee was unavoidable, one looks to whether the party responsible for payment of the maintenance fee exercised the due care of a reasonably prudent person.")

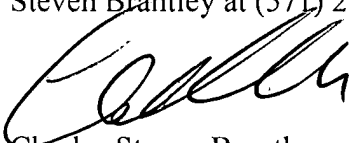
Even if Ms. Jordan proved an attorney told her that it was impossible to take any steps to resume prosecution of the applications without the entire files from Lyon & Lyon, such proof would not prove delay resulting from the attorney's statement was unavoidable. Reliance on a third party representative does not, per se, constitute "unavoidable" delay. When a party relies on an agent to take certain steps, the petition must address not only the party's actions *but also* address the agent's actions or inactions.⁵ A showing is insufficient if it merely establishes that petitioner did everything petitioner could to monitor the agent's actions and inactions, but fails to address the agent's conduct.⁶

The petition fails to prove a reasonable and prudent attorney, with knowledge of rules and policies involving prosecution of applications for patents before the USPTO, would have incorrectly stated nothing could be done to resume prosecution of the applications without the entire files from Lyon & Lyon.

Even if petitioner proved the entire delay until Ms. Jordan spoke with Attorney Scott Harris during or around May of 2005 was unavoidable, the petition could not be granted. Petitioner has failed to provide any evidence to show the entire delay from the date Ms. Jordan met Attorney Harris, until the instant petition was filed on approximately 17 months later, was unavoidable.

If petitioner cannot provide the evidence necessary to establish unavoidable delay, or simply does not wish to, petitioner may wish to consider filing a petition to revive based on unintentional abandonment under 37 CFR 1.137(b). A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by the required reply to the outstanding Office action or notice, the required petition fee (\$770 for a small entity), and a statement that the **entire** delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. A copy of a PDF "fillable" version of a petition to revive form can be found at: http://www.uspto.gov/web/forms/sb0064_fill.pdf.

Telephone inquiries regarding this communication should be directed to Petitions Attorney Steven Brantley at (571) 272-3203.



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⁵ See *Pioneer Inv. Servs. Co. v. Brunswick Assocs. Ltd. P'ship*, 507 U.S. 380, 396, 397 (1993) ("The [Circuit] court also appeared to focus its analysis on whether respondents did all they reasonably could in policing the conduct of their attorney, rather than on whether their attorney, as respondents' agent, did all he reasonable could to comply with the court-order bar date. In this, the court erred. . . . [I]n determining whether respondents' failure to file their proof of claim prior to the bar date was excusable, the proper focus is upon whether the neglect of respondents *and their counsel* was excusable." (emphasis in original)).

⁶ See *Id.*